

Appl. No. 09/629,904  
Amdt. Dated Dec. 9, 2003  
Reply to Office Action of Sept. 10, 2003

### **REMARKS**

The present amendment is being made to facilitate prosecution of the application. Previous Claims 33, 35 and 36 are hereby cancelled without prejudice or disclaimer. Claims 17, 24, 31, 32 and 34 are amended as shown above. Claims 17-32, and 34 are pending with Claims 17, 24, 31, 32 and 34 being independent. No new matter has been introduced.

In the Office Action, Claims 35 and 36 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,438,583 (McDowell). Claims 17-32 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over McDowell in view of U.S. Patent No. 5,805,810 (Maxwell). Claims 33-34 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over McDowell in view of U.S. Patent No. 6,405,243 (Nielsen).

Amended independent Claim 17 recites, *inter alia*, a method for transmitting an e-mail message comprising the steps of:

receiving the e-mail message at an intermediate address, the e-mail message including non-preferred e-mail address data the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address;

parsing the non-preferred e-mail address data from the e-mail message at the intermediate address and determining if there is preferred e-mail address data associated with the non-preferred e-mail address data; and

storing, at a location associated with the intermediate address, the non-preferred e-mail address data when it is determined that there is no preferred e-mail address data associated with the non-preferred e-mail address data.

As understood by Applicant, McDowell relates to a method and apparatus for the re-routing of e-mail sent to a prior address (or an address that is non-working, or temporarily inconvenient) to the new address of an intended recipient. E-mail that is to be sent to a recipient is sent to the former Internet Service Provider (ISP). Because the recipient is no longer a subscriber to the old

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ISP, or because the address at the old ISP is temporarily inconvenient, the e-mail is re-routed to a re-route server. The re-route server then causes the e-mail to be sent to the correct address through a variety of processes.

As understood by Applicant, Maxwell relates to a method of generating mail objects from email messages. The method is performed by a computer system having at least one database containing identifiers for senders of email messages, identifiers for corresponding recipients of mail objects, and address information for both the senders and recipients. The method is broadly comprised steps of three steps: (1) receiving an email message from a sender; (2) locating in the database an identifier for the sender and an identifier for a recipient specified in the email message; and (3) generating a mail object from the email message using the address information in the database for the sender and for the recipient.

Applicant respectfully submits that McDowell and Maxwell, taken alone or in combination, fail to teach or suggest a method for transmitting an e-mail message comprising the steps of:

receiving the e-mail message at an intermediate address, the e-mail message including non-preferred e-mail address data the e-mail message having been previously transmitted to an invalid e-mail address and transmitted back to a sender e-mail address, as recited in Claim 17. Accordingly, Applicant submits that Claim 17 is allowable.

Claim 24 recites, *inter alia*, a method for transmitting an e-mail message that has been sent from a sender address to a previously-known recipient e-mail address and rejected at the previously-known recipient e-mail address and transmitted back to the sender address. Applicant respectfully submits that McDowell and Maxwell, taken alone or in combination, fail to teach or suggest this feature. Therefore, Applicant submits that Claim 24 is allowable.

Claim 31 recites, *inter alia*, a method for transmitting an e-mail message that was sent from a sender address to a previously-known recipient e-mail

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address that is associated with a first service provider, and rejected at the previously-known recipient e-mail address and transmitted back to the sender address. Applicant respectfully submits that McDowell and Maxwell, taken alone or in combination, fail to teach or suggest this feature. Therefore, Applicant submits that Claim 31 is allowable.

Claim 32 recites a method for transmitting an e-mail message that has been sent from a sender address to a second address, rejected at the second address and transmitted back to the sender address, the e-mail message including a non-preferred e-mail address associated with a first service provider. Applicant respectfully submits that McDowell and Maxwell, taken alone or in combination, fail to teach or suggest this feature. Therefore, Applicant submits that Claim 32 is allowable.

Claim 34 recites *inter alia*, a method for transmitting an e-mail message comprising the steps of:

sending a first e-mail message from a sender address to a non-preferred recipient e-mail address; and

receiving, at the sender address, a second e-mail message from a second address, which is independent from the non-preferred e-mail address, indicating that the non-preferred recipient e-mail address is not preferred and that there is not a preferred recipient e-mail address associated with the non-preferred e-mail address.

As understood by Applicant, Nielsen relates to a network-based method and system for forwarding an email message to an updated email address. After a user changes his or her email address, the user sends information regarding the updated email address to an address-change server used in conjunction with the present invention. The address-change server stores the updated email information in its database. When a sender wants to reach a recipient whose email address has changed, the sender sends an email message to the address-change server. The address-change server forwards the updated

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email address to the sender. The sender's email program programmatically forwards the sender's email message to the recipient's new email address.

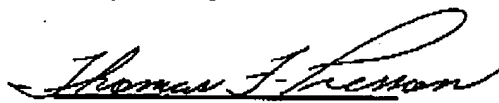
Applicant submits that McDowell and Neilsen, taken alone or in combination, fail to teach or suggest receiving, at the sender address, a second e-mail message from a second address, which is independent from the non-preferred e-mail address, indicating that the non-preferred recipient e-mail address is not preferred, as recited in Claim 34. Therefore, Applicant submits that Claim 34 is allowable.

The other claims in this application are each dependent from one or another independent claim discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's attorney may be reached at (203) 924-3845. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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